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IN THE

Supreme Court of the United States

OCTOBER TERM, 19....

No. 892

MALVERN M. HASHA AND INTERNATIONAL TOOL CO., INC.,
Petitioners,

v.

FOSTER CATHEAD COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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Petitioners pray that a writ of certiorari issue to review the decision in this cause of the United States Court of Appeals for the Fifth Circuit.

OPINION BELOW

A copy of the opinion of the Court of Appeals (R. 2040) upon which review is sought is in the Appendix of this Petition, pages 18a-29a. It is reported at 382 F2d 761 (1967).

A copy of the charge of the Court and special issues submitted to the jury and judgment is also in the Appendix of this Petition, pages 1a-17a.

The Opinion of the Court of Appeals sought to be reviewed was rendered September 11, 1967 (R. 2040-2056).

The Judgment of the Court of Appeals was entered on September 11, 1967 (R. 2058). A Petition for rehearing (R. 2059) was filed September 29, 1967 and it was denied, with no opinion, on October 11, 1967 (R. 2080).

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

QUESTIONS PRESENTED FOR REVIEW

I.

If the state of the evidence considered by a jury, when it answers special issues upon appropriate instructions submitted by the trial Judge, is such that it presents *no conflict*, nevertheless if fair-minded men will honestly *draw different conclusions* or *inferences from the evidence*, may the Court of Appeals deny to a party its constitutional right to trial by jury as guaranteed by the Seventh Amendment of the Federal Constitution on the basis that if the jury's findings *"are based on inferences drawn from exhibits, documents and uncontradicted testimony rather than on conflicting testimony of witnesses . . . such findings are subject to full review as questions of law"*?

II.

May the Court of Appeals in reviewing a jury trial of a patent suit, apply different rules in reviewing the jury fact issues in the patent suit, as compared with the rules it applies in reviewing the jury fact issues in any other suit such as negligence, so that upon review of the jury fact issues in the patent suit, they are changed to become subject to full review as questions of law?

III.

May the Court of Appeals decide a federal question in conflict with applicable decisions of this Court, so that upon review of a jury trial in a patent suit, it treats the fact issue of equivalence as a matter of law and thereby deny a party its right to trial by jury as guaranteed by the Seventh Amendment of the Federal Constitution?

IV.

May the Court of Appeals decide a federal question in conflict with applicable decisions of this Court, so that upon review of a jury trial in a patent suit, it requires proof of the fact issue of infringement in a patent suit be established only by *"conflicting testimony of witnesses"* and thereby deny a party its right to trial by jury as guaranteed by the Seventh Amendment of the Federal Constitution?

CONSTITUTIONAL PROVISION

The Seventh Amendment of the Federal Constitution provides:

> "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law."

STATEMENT OF THE CASE

Petitioners brought this suit in the District Court for infringement of claims 1, 2, 3, 4, 12, 13, 14, 15, 16 and 17 of U. S. Letters Patent No. 3,144,085 (R. 1113).

The suit was tried to the Judge and jury and upon appropriate instructions from the trial Judge (R. 1273-1283; Appendix pp 1a-10a) the jury rendered its answers to special issues finding Patent 3,144,085 valid, and claims

1-4, 12-15, and 17 infringed, *and claim 16 not infringed* (R. 1283-1288; Appendix p 15a).

The Court of Appeals for the Fifth Circuit reversed the jury findings of infringement, because ". . . the findings of infringement *vel non* are based on inferences drawn from *exhibits,* documents, and *uncontradicted testimony, rather than on the conflicting testimony of witnesses . . .*" and therefore such *jury ". . . findings are subject to full review as questions of law".* (Emphasis added)

Following the decision (R. 2040-2057; Appendix pp 18a-29a) of the Court of Appeals of September 11, 1967, Plaintiffs-Appellees filed a Petition for Rehearing (R. 2059-2068), which urged the Court to reconsider its decision, which Petition was denied on October 11, 1967, without opinion (R. 2080; Appendix p 35a).

FEDERAL JURISDICTION OF COURTS BELOW

This is a suit for patent infringement. Jurisdiction of Federal Courts is founded on 28 U.S. Code, Sections 1338 and 1400.

ARGUMENT

Although the Federal Rules of Civil Procedure of 1938 established ". . . one form of action to be known as 'civil action' ", the lower Federal Courts consistently denied a jury trial in patent suits which also involved "equitable" issues until this Honorable Court correctly held in *Beacon Theatres* v. *Westover,* 359 U.S. 500, 79 S.Ct. 948, 3 L.Ed 2d 988 (1959) that even though "equitable" issues may be involved in a civil action, this does not deny a party to a jury trial on fact issues.

Thus, 21 years after the Federal Rules were established, this Honorable Court corrected a grievous state under

which litigants had labored-and enabled patent suits to be tried to a jury, even though "equitable" issues, such as "accounting" or "injunctive" relief were requested.

It is submitted that it is now time for this Honorable Court to "clear the air" in connection with jury findings in a patent infringement suit-and more specifically actually determine if the Courts of Appeal should review the jury findings in a patent suit any differently from the review of jury findings, in other suits, such as *negligence.*

Petitioners believe that the Courts of Appeal have *not the right nor the duty* to review fact findings in patent jury trials *any differently* from review of fact findings in *any* other suit such as negligence.

In the present case, the Court of Appeals did *not* hold the jury findings *"clearly erroneous"*, or that there was *"insufficient evidence to support the jury finding"* of infringement. On the contrary, the Court of Appeals expressly stated that these were exhibits, documents, and testimony from which the jury drew its inference of infringement (R. 2051; Appendix a;) but held that *unless the jury's inference is based on conflicting testimony of witnesses,* then the jury's findings resulting from its inference *are subject to full review as questions of law.* (R. 2051 Appendix 27a).

The foregoing is clearly in conflict with the decisions of this Honorable Court, and if permitted to stand denies to Petitioners their constitutional right of trial by jury as guaranteed by the Seventh Amendment of the Federal Constitution. For example in *Richmond & Danville R. Co.* v. *Powers,* 149 U.S. 43, 45, 13 S.Ct. 748, 749 (1893) this Honorable Court in a negligence suit states:

> "It is well settled that, where there is uncertainty as to the existence of either negligence or contributory

> negligence, the question is not one of law, but of fact, and to be settled by a jury; and this whether the uncertainty arises from a conflict in the testimony, *or because, the facts being undisputed, fair-minded men will honestly draw different conclusions from them.*" (Emphasis added)

In *Gunning* v. *Cooley,* 281 U.S. 90, 94, 50 S.Ct. 231, 233, (1930), this Honorable Court again states in a negligence action:

> "Where uncertainty as to the existence of negligence arises from a conflict in the testimony or because, the *facts being undisputed, fair-minded men will honestly draw different conclusions from them, the question is not one of law but of fact to be settled by the jury.*" (Emphasis added)

In *Baltimore & O. R. Co.* v. *Postum,* 177 F. 2d 53 (C.A.DC, 1949) and *Wells* v. *Warren,* 328 F. 2d 666 at 668, (5th Cir., 1964) *Richmond & Danville R. Co.* v. *Powers, supra,* is cited with approval.

Thus the Court of Appeals has clearly invaded the province of the jury in the present case, and *that it reaches a different conclusion from the*"... *exhibits, documents, and uncontradicted testimony* ... shows in and of itself that *reasonable minds may draw conflicting or contrary inferences from the same evidence and* therefore it is for the *jury* in the present case to determine which is the correct inference.

Certainly, that the present case involves a patent should not be any reason for different rules to be applied by the Court of Appeals in reviewing the jury fact findings. This Court has already disposed of this in *Graham* v. *John Deere Company of Kansas City* 383 U.S. 1, 17, 18 86 S.Ct. 684, 694 15 L.Ed 2d 545 (1966). In that patent suit this Honorable Court at pages 17 and 18 discussed the difficulties in apply-

ing the "nonobviousness" test of 35 U.S.C. §103 relating to patent validity and states as follows:

> ". . . the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. . . . Against this background, the obviousness or the nonobviousness of the subject matter is determined.
>
> "This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. *The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development.*" (Emphasis Added)

Obviously if a factual issue relating to patent validity can be compared with the factual issues in negligence, then the manner of reviewing fact findings in patent infringement by a Court of Appeals should be the same as when it reviews fact findings in negligence.

Jury trials in patent cases are no different from trials in other cases, as stated in *Hansen* v. *Safeway Stores*, 283 F. 2d 336 (9th Cir. 1956):

> *"In a jury trial of a patent case, the same rules prevail as in ordinary cases.* There is no special exception simply because an alleged patent is involved."

The Court of Appeals has not done so in this case and has thereby denied Petitioners their right to trial by jury. This is particularly true where the Court of Appeals in its decision (R. 2051; Appendix 27a) rules there must be *"conflicting testimony of witnesses" to raise a jury issue.* This is contrary to the consistent prior decisions of this Court as reflected by *Richmond & Danville R. Co.* v. *Powers,*

Gunning v. *Cooley* and *Baltimore & O. R. Co.* v. *Postum*, supra.

Furthermore the Court of Appeals has treated the fact issue of "equivalence" as a question of law subject to full review by it. Equivalence is a *fact finding* and not a question of law. *Graver Tank Company & Mfg. Co., Inc.* v. *Linde Air Products* 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950). At 339 U.S. page 609 this Court states:

"A finding of equivalence is a determination of fact".

The trial court and jury had fully explained to it the operation of defendant's device and one form of plaintiffs' device under the patent in suit. It is for the jury to determine the credibility of the witnessess— certainly not the *right* nor *duty* of the Court of Appeals.

The Court of Appeals decision (R. 2040-2044) generally accurately describes the operation involved in adding a joint of pipe to a drill string, but the word "spring" before "chain" in its decision (R. 2042, 2043) should be "spinning".

Additionally, the Court of Appeals usurped the jury's function in determining the scope of "equivalence" to be given the claims of the patent in suit. For example, the record amply shows that plaintiffs' "Kelly Spinner" was the first device to ever rotate to the right above a left hand thread in a drill string without disconnecting the kelly from the adjacent sub at its upper end. (R. 349-364, 440-441, 446-447).

Even the Court of Appeals in its decision admits (R. 2048; Appendix 25a) that *"The invention revolutionized the operation it was designed to accomplish."*

For the Court of Appeals to substitute its finding for that of the jury on infringement where the trial court has given appropriate instruction on "equivalence", is clearly improper, contrary to applicable decisions of this

court and denies Petitioners their duly constituted right to trial by jury. This Court in *Tennant* v. *Peoria & P.U.R. Co.* 321 U.S. 29, 35, 64 S.Ct. 409, 412, (1944) states it thusly at 321 U.S. 35

> "It is not the function of a court to search the record for conflicting circumstantial evidence in order to take the case away from the jury on a theory that the proof gives equal support to inconsistent and uncertain inferences. The focal point of judicial review is the reasonableness of the particular inference or conclusion drawn by the jury. It is the jury, not the court, which is the fact-finding body. It weighs the contradictory evidence and inferences, judges the credibility of witnesses, *receives expert instructions,* and draws the ultimate conclusion as to the facts. The very essence of its function is to select from among conflicting inferences and conclusions that which it considers most reasonable. Washington & Georgetown R. Co. v. McDade, 135 U.S. 554, 571, 572, 10 S.Ct. 1044, 1049, 34 L. Ed. 235; Tiller v. Atlantic Coast Line R. Co., supra, 318 U.S. 68, 63 S.Ct. 451, 143 A.L.R. 967; Bailey v. Central Vermont Ry., 319 U.S. 350, 353, 354, 63 S.Ct. 1062, 1064, 87 L.Ed. 1444. *That conclusion, whether it relates to negligence, causation or any other factual matter, cannot be ignored. Courts are not free to reweigh the evidence and set aside the jury verdict merely because the jury could have drawn different inferences or conclusions or because judges feel that other results are more reasonable.* (Emphasis added)

There is no rule which states that a fact issue must be established by *"conflicting testimony of witnesses"* as held by the Court of Appeals in its decision (R. 2051; Appendix 27a). Proof of equivalence *can be made in any form,* including documents, exhibits and testimony. *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products, supra,* states at page 609:

> "A finding of equivalence is a determination of fact. Proof can be made in any form: . . ."

A party is not required to have a paid expert parrot "equivalence" when the accused device is in the court room, explained in detail to the trial court and jury both as to construction and operation. The jury is assumed to have some mentality, particularly where it includes at least one graduate engineer and additional jurors who are familiar with mechanical equipment.

Some mention should be made of this Court's decision in *Black Diamond Coal Min. Co.* v. *Excelsior Coal Co.*, 156 U.S. 611, 39 L.Ed 553 (1895). This Court overturned the jury's verdict there on the basis of an *incorrect instruction by the trial court* as to the scope of the patent in suit. But the *Black Diamond* case, *supra,* cannot stand for the proposition that where the evidence upon which infringement is to be determined is *undisputed,* the question of infringement should not be submitted to the jury. The *Black Diamond* case viewed the Court's charge and determined that it was improper, thus distinguishing from the case at bar.

Also in *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265, 48 L.Ed. 437 (1904) the defendant's device was covered by and shown in its patent, and this Court there held that the two documents could be compared (i.e., plaintiff's patent and defendant's patent) to dispose of the issue-without extrinsic evidence. The Court stating at 192 U.S. page 276:

> ". . . As in each of the patents in question *it is apparent from the fact of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter, and as we are able, from mere comparison, to comprehend what are the inventions described in each patent,* and, from such comparison, to determine whether or not the Diehl device is an infringement upon that of Cra-

> mer, the question of infringement or no infringement is one of law, and susceptible of determination on this writ of error."

Similarly in *Sanitation Refrigeration Co.* v. *Winters* 280 U.S. 30, 74 L.Ed. 147, plaintiff had a patent and defendant had a patent. This Court held that infringement could thus be determined by comparing the two patents. These facts are very similar to *Singer Mfg. Co.* v. *Cramer, supra,* and it is not surprising that the Sanitary decision refers to the Singer decision in stating that under such circumstances, infringement becomes a question of law.

However, this is not the situation in the present case, as defendant's president felt it necessary to gather the jury around him and the model 77 Kelly Spinner, "he *designed*" (R. 727) and explain it in detail (R. 729-768) — its operation was not apparent without testimony; nor does Foster have a patent on his kelly spinner. The jurors therefore, in this case are best able to determine the credibility of Mr. Foster's testimony and the accuracy of his description of his alleged infringing device and to *visually* compare the Foster device with the patent in suit.

Furthermore, it is submitted that this description by Mr. Foster and the "on sight" inspection by the jurors and comparison by them with one physical form of plaintiff's patented device is the *best evidence* — not some attorney's personal description in a brief.

Under the decisions of this Court, to permit Courts of Appeals to substitute its different inferences, without viewing the demeanor of the witnesses and without an opportunity to determine their credibility is grossly improper.

Nor does *McRosky* v. *Braun Mattress Co.* 107 F.2d 143 (9th Cir. 1939) support the Court of Appeals decision in this case because in the instant suit the jurors (R. 106, 107,

729-768) closely examined defendant's device and one form of plaintiff's device under its patent in suit. Such were not the facts in the McRosky case, supra.

CONCLUSION

For the foregoing reasons, this petition for a Writ of Certiorari should be granted, and, it is respectfully requested that your petitioners may be permitted by the Court to present this case on oral argument.

Respectfully submitted,

.....

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Counsel for Petitioner

PROOF OF SERVICE

Service of this Petition has been made upon Foster Cathead Company, Respondent, by mailing a copy postage prepaid to JEFFERSON DAVIS GILLER, ESQ., 8th Floor, Bank of the Southwest Building, Houston, Texas 77002, this ..... day of December, 1967.

.....

Attorney for Petitioners

APPENDIX

IN THE

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF TEXAS

MALVERN M. HASHA, AN INDIVIDUAL, AND
INTERNATIONAL TOOL COMPANY, A CORPORATION,
Plaintiff,

v.

FOSTER CATHEAD, A CORPORATION,
Defendant.

CIVIL ACTION NO. 3-897 FOR INFRINGEMENT OF
UNITED STATES LETTERS PATENT NO. 3,144,085

CHARGE OF THE COURT AND SPECIAL ISSUES SUBMITTED TO JURY

Filed Oct. 11, 1965.

Members of the Jury:

This case concerns a patent on an oil field tool No. 3,144,085, commonly called a Kelly Spinner.

The Plaintiffs allege that the patent in suit is valid and that it was infringed by the Defendant. The Defendant denies that the patent in suit is a valid patent and also denies infringement.

Section 101 of Title 35 of the United States Code dealing with the patent laws of the United States provides that:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements . . ." of the Patent Laws.

In this case we are concerned with the claimed invention of a machine — a power spinner unit for oil well swivels.

The question now being presented to you is: Was the patent in suit a valid patent?

Here the defendant has the burden of coming forward with clear and convincing evidence to establish that the patent in suit is not valid. This is so, because the law gives to the holder of a patent the benefit of a presumption that the patent is valid. In other words, the law presumes, in the absence of clear and convincing evidence to the contrary, that the Patent Office correctly issued the patent.

The Defendant here asserts that the patent in suit is not valid or enforceable for the following reasons:

1. Because if otherwise valid, one or more of the claims to the patent in suit do not meet the essential requirement of the Patent Laws that the claims of a patent must point out particularly and distinctly claim the alleged invention.

2. Because if otherwise valid, one or more of the claims of the patent in suit do not meet the essential requirement of the Patent Laws that the claims of a patent must be supported by the disclosure or specification which comprises the written description of the alleged invention.

3. Because the claimed invention shown in the patent in suit is not "New" within the meaning of that word as used in the Patent Laws.

4. Because the subject matter of the claimed invention as a whole was obvious to a person having ordinary skill in the art to which said subject matter pertains.

5. Because if otherwise valid and enforceable, the Plaintiffs made fraudulent representations to the Patent Office which resulted in the allowance and issuance of one or more of the claims of the patent in suit.

It has been brought out by evidence herein that Lewis Foster filed an application for Letters Patent on a device, that thereafter he copied some of the claims of the Hasha Patent for the purpose of invoking an interference in the Patent Office. An interference proceeding is one by which the Patent Office determines which if either of two applicants for a patent is the first inventor, or if a patent should issue to either applicant. It has been further brought out in evidence that Lewis Foster abandoned his patent application before the interference was formally declared, so that the interference proceeding did not actually take place.

However, by so doing, the Defendant herein has not lost its right to question here the validity of the patent in suit.

In determining the various requirements of the Patent Laws we look to the state of things as they existed at the time of the claimed invention. In the absence of evidence establishing some other date, the time of the claimed invention is the date on which the original application for a patent was filed in the Patent Office.

In this case the application which matured into the patent in suit was filed in the Patent Office on April 12, 1962. This date is presumed to be the date of the invention. The Plaintiffs contend that claims 1, 2, 3, 4, 12, 13, 15, and 17 of the application filed April 12, 1962 are included in the application filed November 24, 1961 and that said date should

be considered as the filing date. The Defendant contends that the Plaintiffs added claims after April 12, 1962 which constituted new matter with respect to the application filed on April 12, 1962 and that Plaintiffs are only entitled to the date of March 9, 1964 as the filing date.

You are instructed that new matter is added only when the addition contains disclosures essentially and substantially uncommon to the original disclosure; that is when the matter added materially departs from the spirit and scope of the original disclosure.

A patent in order to be valid must meet the essential requirements of the patent laws. Among the conditions and requirements of the patent laws just referred to is the requirement of Section 111 of Title 35 of the United States Code that the application for the patent shall be in writing, under oath and shall contain a drawing and specification.

As to what must be included in the specification in order for the patent to be valid, Section 112 of Title 35 of the United States Code provides, in part, that:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Whenever a valid patent is issued by the Patent Office, the patent laws in effect give the inventor a 17-year mo-

nopoly in the manufacture and sale and use of the invention in return for a disclosure of the best maner or method contemplated by the inventor for the construction and operation of the machine.

The disclosure is made a part of the letters patent as issued and, as already stated, is known as the specification. The disclosure in the specification must contain

"A written description of the invention, and of the manner and process of making and using it", and this description must be set forth "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains" — here, the oil well tool art — "to make and use" the machine.

In determining whether the claimed invention of the patent in suit is disclosed in the patent "in such full, clear, concise and exact terms as to enable person skilled in the art" of making power spinner units for well swivels "to make and use the same", as required by the patent laws, you should consider what is shown by the drawings as well as what is shown in the specifications. In other words, the specification is to be read in light of the drawings. You are instructed that if you find that the claims of the patent in suit do not particularly point out and distinctly claim the alleged invention of the patent in suit, then the patent is not a valid patent because it does not meet the essential requirements and conditions of the patent laws.

Another of the essential elements of the patent laws is that the patent must disclose sufficient information in the specification and drawings to enable a person skilled in the oil well tool art to make and use the power spinner unit there claimed to have been invented. Stated otherwise, the claims of the patent in suit must be supported by the disclosure made in the specification.

A further essential element of the patent laws is that in order for a patent to be valid it must disclose an invention which is "new". You are instructed that in order to be "new" within the meaning of that word as used in the patent laws, the machine must be one that either produces an unusual or improved or advanced result unknown to the prior art at the time of the claimed invention, or produces an old result in an unusual and substantially more efficient or more economical way. As prior art is used herein, the term means: (a) That which was known or used by others in this country, or patented or described in printed publication in this or a foregn country, before the invention thereof by the applicant, or (b) that which was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for the patent in the United States, or (c) that which is described in a patent granted on an application for a patent by another filed in the United States before the invention thereof by the applicant for patent or (d) an invention made in this country by another who has not abandoned, suppressed or concealed it.

By the term "publication" is meant the public announcement of information.

By the term "public" is meant accessible or available to members of the community.

You are further instructed that a patent is not valid, even though the subject matter thereof was not substantially disclosed or described in the prior art, if the differences between the subject matter sought to be patented in the prior art are such that the subject matter as a whole would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art to

which such subject matter pertains — in this case, the art of oil well tools.

In determining whether or not the differences between the subject matter of the claim and the prior art would have been obvious at the time the alleged invention was made to a person having ordinary skill in the art, the person having ordinary skill in the art is conclusively presumed to know all the prior art.

It is possible to obtain a valid patent on a combination of old elements if the old elements are assembled or combined in such a way as to produce a new or advanced or improved result, that is to say, if the combination or assembly of old elements produces, in some way or manner, a surprising or unusual result which would not have been expected by a person having ordinary skill in the oil well tool art.

You are instructed that when a number of old elements is assembled or brought together and do not combine with one another to produce in some way or manner a surprising or unusual result, it is known as a mere "aggregation" of old elements, and under the law a mere "aggregation," being obvious to one having ordinary skill in the art, cannot support a patent.

The Defendant also contends that the Plaintiffs made fraudulent material representations to the Patent Office, and in reliance upon these representations the Patent Office issued the patent in suit. You are instructed that if you find that the Plaintiffs knowingly made material misrepresentations to the Patent Office and that the Patent Office relied upon his representations, and thereafter issued a patent, the patent issued is unenforceable because of the fraud perpetrated upon the Patent Office.

With reference to the question of infringement, you are instructed that for any of the claims at issue in the patent in suit to be infringed by Defendant's Model 77 device, it is necessary that the device contain each and every element of that claim or the equivalent of one or more such elements, and that the Model 77 device performs substantially the same function in substantially the same manner to achieve substantially the same results as the disclosure of the patent in suit, as incorporated in the particular claim.

For an element of a device to be the equivalent of an element in a claim at issue, it is necessary that the element in the claim and the element in the device perform substantially the same function in substantially the same way to obtain subtantially the same result.

The only claims of the patent which are charged to be infringed in this case are Claims 1, 2, 3, 4, 12, 13, 15, 16 and 17. Claims 15 and 16 are known as dependent claims in that each claim depends from Claim 4. You are instructed that Claim 15 includes everything recited in Claim 4, plus the additional subject matter recited in Claim 15, and that Claim 16 includes everything recited in Claim 4, plus the additional subject matter recited in Claim 16.

In considering the issue as to whether the Defendant has infringed the patent in suit, you are to consider each of Claims 1, 2, 3, 4, 12, 13, 15, 16 and 17 separately, and to make a separate finding with respect to each.

The burden is on the Plaintiffs to prove by a preponderance of the evidence that Defendant's devices infringe the patent in suit.

You are instructed that by the term "preponderance of the evidence" as used in this charge is meant the greater weight and degree of credible testimony before you.

By the term "clear and convincing evidence" is meant the degree of proof which will produce in your mind a firm belief or conviction as to the truth of the matter sought to be established.

In performing your duties as Jurors you are not to single out one instruction alone but must consider the instructions as a whole.

You as jurors are the sole judges of the facts and the credibility of the witnesses and of the weight and credit to be given to the testimony, but the law you are bound to receive from the Court and be bound thereby as it is given you herein.

You are further instructed that while you are deliberating upon your answers to the special issues that are submitted to you, you will not mention, nor refer to, nor take into consideration any matter, fact, or circumstance other than the testimony that has been admitted before you, all of which I instruct you particularly to observe and obey.

You are further instructed that each special issue must be answered by unanimous vote of the Jury.

In arriving at your verdict, you are instructed not to let bias, prejudice, sympathy or any such emotion play any part in your deliberations.

This case should be considered and decided by you as an action between persons of equal standing in the community, of equal worth. All persons stand equal before the law and are to be dealt with as equals in a Court. Corporations are entitled to the same fair trial as a private individual.

You should carefully scrutinize all the testimony given, the circumstances under which each witness has testified, and every matter in evidence which tends to indicate

whether a witness is worthy of belief. Consider also any relation each witness may bear to either side of the case and the manner in which each witness might be affected by the verdict.

During the trial certain testimony has been given by deposition. Such testimony is entitled to the same consideration insofar as possible, is to be judged as to credibility and weighted by the Jury in the same way as if the witness had been present.

The rules of evidence ordinarily do not permit witnesses to testify as to opinions or conclusions. An exception to this rule exists as to "expert witnesses". Witnesses, who by education and experience, have become expert in some art, science, profession, or calling, may state an opinion as to relevant and material matter, in which they profess to be expert, and may also state their reasons for the opinion.

You should consider each expert opinion received in evidence in this case and give it such weight as you may think it deserves.

The evidence in this case consists of the sworn testimony of the witnesses, exhibits, and all facts which may have been admitted or stipulated. Any evidence as to which an objection was sustained and any evidence ordered stricken by the Court must be entirely disregarded.

Bearing in mind the foregoing instructions and definitions you will answer the following special issues.

Special Issue No. 1:

Do you find from clear and convincing evidence that the claims, if any, of the patent in suit were not entitled to April 12, 1962 as an effective filing date?

Answer "They were not" or "They were" as to each of the following:

Claim 1 They were; Claim 2 They were; Claim 3 They were; Claim 4 They were; Claim 12 They were; Claim 13 They were; Claim 15 They were; Claim 16 They were; Claim 17 They were.

If you have answered "They were not" to any part of parts of Special Issue No. 1, then answer Special Issue No. 2. Otherwise, do not answer Special Issue No. 2.

Special Issue No. 2:

From a preponderance of the evidence, what date do you find was the effective filing date of each of the claims of the patent in suit?

Specify only as to those which were answered "They were not" in Special Issue No. 1.

Claim 1 .....; Claim 2 .....; Claim 3 .....;
Claim 4 .....; Claim 12 .....; Claim 13 .....;
Claim 15 .....; Claim 16 .....; Claim 17 .....

Special Issue No. 3:

Do you find from clear and convincing evidence that any of the claims of the patent in suit do not particularly point out and distinctly claim the subject matter which the Plaintiffs regard as their invention? Answer "They do not" or "They do" as to each of the following:

Claim 1 They do; Claim 2 They Do; Claim 3 They Do; Claim 4 They Do; Claim 12 They Do; Claim 13 They Do; Claim 15 They Do; Claim 16 They Do; Claim 17 They Do.

Special Issue No. 4:

Do you find from clear and convincing evidence that any of the claims of the patent in suit are not supported by the

disclosure made in the specification of U. S. Letters Patent No. 3,144,085?

Answer "They are not" or "They are" as to each of the following:

Claim 1 They are; Claim 2 They are; Claim 3 They are; Claim 4 They are; Claim 12 They are; Claim 13 They are; Claim 15 They are; Claim 16 They are; Claim 17 They are.

Special Issue No. 5:

Do you find from clear and convincing evidence that any of the claims in suit are not "new" within the meaning of that word as used in the patent laws?

Answer "They are not" or "They are", as to each of the following:

Claim 1 They are; Claim 2 They are; Claim 3 They are; Claim 4 They are; Claim 12 They are; Claim 13 They are; Claim 15 They are; Claim 16 They are; Claim 17 They are.

Special Issue No. 6:

Do you find from clear and convincing evidence that the difference between the subject matter of the claims taken individually of the patent in suit and the prior art are such that the subject matter thereof as a whole would have been obvious at the time the alleged invention thereof was made to a person having ordinary skill in the art to which said subject matter pertains?

Answer "yes" or "no" as to each of the following:

Claim 1 No; Claim 2 No; Claim 3 No; Claim 4 No; Claim 12 No; Claim 13 No; Claim 15 No; Claim 16 No; Claim 17 No.

Special Issue No. 7:

Do you find from clear and convincing evidence that any one or more, if any, of the following statements made by Plaintiff-Hasha to the United States Patent Office was false at the time the statement was made:

(a) "With the present manner of connecting well pipe in a pipe string, it is impossible to continue rotation of the suspended well string while connecting a pipe section therewith"

Answer "yes" or "no" Answer No

(b) "The present invention has for one of its primary objects a method of connecting and disconnecting pipe sections in a suspended well string which does not interfere with continued rotation of the suspended well string as the connecting and disconnecting of the pipe sections is accomplished."

Answer "yes" or "no" Answer No

If you have answered either or both of the paragraphs of Special Issue No. 7 "yes", then answer Special Issue No. 8. Otherwise, do not answer Special Issue No. 8.

Special Issue No. 8:

Do you find from clear and convincing evidence that such statement or statements, if any, made to the Patent Office was or were material?

Answer "yes" or "no" as to each statement set out in special issue 7.

Answer (a) ..... (b) .....

If you have answered either (a) or (b) of Special Issue No. 7 "Yes", then answer Special Issue No. 9. Otherwise, do not answer Special Issue No. 9.

Special Issue No. 9:

Do you find from clear and convincing evidence that Plaintiff-Hasha knew that such statement or statements, if any, was or were false?

Answer "yes" or "no" as to each statement set out in special issue 7.

Answer (a) ..... (b) .....

If you have answered either (a) or (b) of Special Issue No. 7 "yes", then answer Special Issue No. 10.

Otherwise, do not answer Special Issue No. 10.

Special Issue No. 10:

Do you find from clear and convincing evidence that the Patent Office relied upon the false statement or statements, if any, made by Plaintiff-Hasha in issuing the patent in suit?

Answer "yes" or "no" as to each statement set out in special issue 7.

Answer (a) ..... (b) .....

Special Issue No. 11:

On what date do you find from clear and convincing evidence was Defendant's Model 77 in public use?

Answer by giving the date: Dec. 5, 1963.

Special Issue No. 12:

Do you find from a preponderance of the evidence that Defendant's device Model 77 infringes any of the claims of U. S. Letters Patent No. 3,144,085?

Answer "yes" or "no" as to each of the following:

Claim 1 Yes; Claim 2 Yes; Claim 3 Yes; Claim 4 Yes; Claim 12 Yes; Claim 13 Yes; Claim 15 Yes; Claim 16 No; Claim 17 Yes.

You will retire to the jury room, select your own foreman and write your answers to the special issues in the blank space left after each special issue for that purpose.

Your foreman will sign the form of verdict as it is shown below.

SARAH T. HUGHES,
U. S. District Judge.

Verdict:

We, the Jury, have answered the foregoing special issues as indicated above and herewith return the same into Court as our verdict in this case.

LYLE W. OZMUN,
Foreman of the Jury.

JUDGMENT

Filed Nov. 1, 1965.

In the United States District Court for the Northern District of Texas, Dallas Division.

Malvern M. Hasha, an individual and International Tool Company, Inc., a corporation, Plaintiff,

v.

Civil Action No. 3-897.

Foster Cathead Company, a corporation, Defendant.

This action came on for trial before the Court and a jury, The Honorable Sarah T. Hughes, District Judge, presiding; and the issues having been duly tried and the jury having duly rendered its verdict:

It is Ordered, Adjudged, and Decreed:

1. That claims 1, 2, 3, 4, 12, 13, 15, 16, and 17 of Letters Patent of the United States No. 3,144,085 issued on August 11, 1964 are valid, that Defendant, Foster Cathead Company, has infringed claims 1, 2, 3, 4, 12, 13, 15, and 17 thereof by manufacturing and selling devices covered thereby identified as Defendant's Model 77 Kelly Spinner, and that Defendant, Foster Cathead Company, has not infringed claim 16 thereof.

2. That Plaintiff, Malvern M. Hasha, is the owner of the entire right, title, and interest in and to said Letters Patent No. 3,144,085 subject to the rights of Plaintiff, International Tool Company, Inc., therein.

3. That the Plaintiffs have not misused United States Letters Patent No. 3,144,085.

4. That Defendant, Foster Cathead Company, its officers, directors, agents, employees, and attorneys, and those in

active concert or participation with them, who shall, by personal service or otherwise, have received actual notice of the same, be enjoined and restrained from and after November 15, 1965 from infringing claims 1, 2, 3, 4, 12, 13, 15, and 17 of said United States Letters Patent No. 3,144,085, or any of said claims in any way whatsoever; and the Clerk of the Court is hereby directed to issue an injunction in due form of law upon the aforementioned date for service upon Defendant, Foster Cathead Company, its officers, directors, agents, employees, and attorneys by the Marshal.

5. A second jury trial as to the issues of damages and the willful nature of Defendant's infringement and a determination of reasonable attorneys' fees and an assessment of treble damages will be reserved to a later date.

6. That except for the issues reserved for subsequent trial in paragraph 5 hereof, all relief not specifically granted herein be and the same is denied.

SARAH T. HUGHES,
United States District Judge.

IN THE

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 23541

FOSTER CATHEAD COMPANY,
Appellant,

versus

MALVERN M. HASHA and INTERNATIONAL TOOL COMPANY, INC.,
Appellees.

Appeal from the United States District Court for the Northern District of Texas.

September 11, 1967.

Before BELL, GODBOLD and DYER, Circuit Judges.

DYER, Circuit Judge: This is a suit for infringement of United States Patent No. 3,144,085, issued August 11, 1964, to Malvern M. Hasha, covering a "Power Spinner Unit for Well Swivels" (commonly known as a kelly spinner) a device used in connection with oil well drilling. Judgment on a jury verdict was entered for appellees[1] holding claims 1, 2, 3, 4, 12, 13, 15, 16 and 17 of the patent valid[2] and, except for claim 16, infringed.

[1] For simplicity, the appellant will be referred to as Foster, and the appellees as Hasha and International Tool.

[2] These claims were the only ones sued upon. The claims of the patent vary only in the details of the recitation of the com-

ponents of the spinner. Claims 1 and 4 are set forth verbatim and the remaining claims summarized.

Claim 1 recites:

"A device for rotating the spindle of a swivel including:

(a) support means adapted to be carried by a swivel having a spindle,

(b) motor means mounted on said support for imparting rotation to the spindle of the swivel,

(c) gear means between the spindle and said motor means, and

(d) means to move gear means to disconnect said motor means from the spindle."

Claim 2 includes all of the elements of claim 1 and adds only that the motor has a connection for receiving power whereby the motor may be actuated.

Claim 3 is similar to claim 1 except, like claim 2, it adds that the motor has a connection for receiving power. Additionally, it describes the gear for driving the spindle somewhat differently. In paragraphs (c) and (d) of claim 1 it is recited that there are gears between the spindle and the motor and means to move the gears to disconnect the motor from the spindle. In the corresponding elements (d) and (e) of claim 3 it is stated that there is means for coupling the motor to the spindle and that means is uncoupled but operable to couple the motor to the spindle when the motor is turned on.

In none of the first three claims is the word "ring gear" mentioned. The term "ring gear" is used only in claim 4, its dependent claim 15, and claim 16.

Claim 4 is similar to claim 3 except that the ring gear is referred to by name rather than by gear means and there is added that the motor is fixedly supported.

Claim 4 recites:

"In a power spinner for rotating the spindle of a swivel,

(a) motor means adapted to be supported on the swivel and having a connection for receiving power from a power source whereby said motor may be actuated,

(b) a ring gear adapted to extend about the spindle for transferring rotation of said motor to the spindle,

(c) means interposed by the said motor means and the spindle for coupling said motor and the spindle in one position for rotation, and for uncoupling said motor from the spindle in another position, and

The evidence involves the problem of adding additional sections of pipe to the drill string in oil well drilling operations. To accomplish this before Hasha conceived the kelly spinner of the patent in suit, it was necessary to screw the kelly (an elongated square piece of pipe at the top of the well string) to the additional pipe by a "spring chain" and "cathead." The spring chain is a length of chain connected to a cable which is wound on the cathead (powered reel). A roughneck manually wraps loops of the chain around the upper end of the additional pipe. When the cathead is rotated by power, it winds the cable onto the reel. This pulls on the chain causing the pipe to rotate and thus screws the pipe onto the kelly. While the cable is pulling the chain off of the pipe, the roughneck must hold the remaining loops of chain tightly against the rotating pipe with his hands to prevent the remaining loops from slipping. The chain must then be held to cause it to rotate the pipe. The chain is often slippery with mud and grease, and if the roughneck's hands slip off the chain, its loose ends whips around with dangerous force.

After the section of pipe has been connected to the kelly it must be again rotated by the spinning chain and cathead

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(d) said motor being fixedly supported on the swivel in both positions."

Claim 12 is similar to claim 1 but adds that the support includes an upper member and a lower member and that the motor has a connection for receiving power. It also describes the gearing between the motor and the spindle in somewhat more detail.

Claim 13 is identical to claim 12 except there is omitted the reference to there being an upper member and a lower member in the support.

Claim 15 is dependent upon (and includes all of) claim 4 and adds to claim 4 that the motor is capable of rotating the ring gear in both directions.

Claim 17 is similar to claim 5 but adds that the motor is reversible.

These claims are set forth in full in the appendix.

to connect it with the drill string. To accomplish this, the spring chain is wrapped around the upper end of the pipe in the rotary table. The lower end of the section of pipe is stabbed into the upper end of the pipe projecting from the rotary table. The roughneck throws the wraps of chain from the upper end of the pipe in the rotary onto the lower end of the pipe section. Again, the cathead is turned on and the chain is unwound from the pipe to rotate the kelly and the pipe to thread the two pipe ends together. The roughneck must hold his hands on the chain wrapped around the pipe to prevent the chain from slipping.

The patented kelly spinner is a device, which, when attached to the bottom of the swivel (located at the upper end of the kelly), is used to rotate the kelly to connect it to and disconnect it from drill pipe. This kelly spinner has an upper and lower plate secured together by bolts. These plates have a centrally located opening through them so that they may be slipped over the swivel spindle and the upper plate may be secured by bolts to the swivel housing. A large circular ring gear is fastened to the swivel spindle between these upper and lower plates so that rotation of the ring gear will rotate the swivel spindle and hence the kelly. A motor is secured to the lower plate on one side of the ring gear. The motor turns a gear mounted on a support on a shaft.

When power is supplied to the motor the support moves the gear upwardly to engage and turn the ring gear and hence the spindle and the kelly. When the power is withdrawn from the motor the gear automatically withdraws downwardly from the ring gear to its beginning position and permits the kelly to be turned by the rotary table.

The gear and apparatus for moving the gear upwardly to engage the ring gear when the motor is turned on and

to withdraw the gear when the motor is turned off is commonly called a Bendix.

In making connections, the kelly spinner rotates the kelly to connect the threaded lower end of the kelly to the upper end of the additional section of pipe. The lower end of the pipe section is then aligned with the top of the drill string supported in the rotary. The kelly spinner again rotates the kelly to thread the section into the drill string. The kelly is then lowered to seat the kelly bushing in the rotary so that drilling operations may resume. The kelly spinner is designed to rotate the spindle in either a clockwise or counter-clockwise direction by the operation of controls.

The accused device is known as Foster's Model 77 kelly spinner. It has a train of three small gears which drive a ring gear. The first and smallest gear is driven by a shaft from the motor. This is always engaged with and rotates the second gear. Under this is a third small gear which is always engaged with teeth on the outside edge of a large ring gear and rotates the latter. Below and extending inside the ring gear is a drag ring carrying several jaws (gripping elements) mounted on pivot posts on the drag ring. Each of these jaws has teeth on one end that are always engaged with teeth on the inside edge of the ring gear. Inside of the drag ring is the swivel spindle.

The motor is activated with the jaws retracted from the spindle and turns the train of small gears which rotate the ring gear clockwise. Friction holds the drag ring stationary during the initial movement of the ring gear and because the jaws are always engaged with teeth in the ring gear this initial movement of the ring gear relative to the drag ring causes these jaws to rotate on their pivots and extend until they contact and grip the spindle. When these jaws

have gripped the spindle the force of the ring gear causes the jaws and drag ring to move with the ring gear as a unit in a clockwise direction, and turn the spindle in the same direction. The motor is reversible and when its direction of rotation is reversed the jaws retract and are moved free of the spindle and returned to their original position so that they are no longer engaged with the spindle and do not rotate it counterclockwise. The only way to make the Model 77 spinner rotate the pipe in reverse is to disassemble it, lift out the jaws, turn them over, and reassemble the device.

Foster attacks the jury finding of validity of Hasha's patent contending that if the claims are given the sweeping construction sought by Hasha, then all of them are invalid because of (1) overclaiming, (2) Foster's prior power tong, (3) the Arthur power swivel, or (4) the functionality and indefiniteness of the claims at their only possible point of novelty. Foster further urges that without regard to infringement, claims 1-4, 12 and 13 are invalid because of the Bendix arrangement.

As we shall later point out, the claims of Hasha's patent are embarrassingly broad and we are unwilling to extend his monopoly far beyond the invention. *Cf. Edwards* v. *Johnston Formation Testing Corporation*, 5 Cir. 1932, 56 F. 2d 49, 50. This pretermits the necessity for an extended discussion of the many pronged attack on validity by Foster premised upon a finding of infringement.

We reject Foster's contention that the claims (including the Bendix arrangement) are invalid due to their functional language,[3] because we find the point of novelty is

[3] Citing *General Electric Co.* v. *Wabash Appliance Co.*, 304 U.S. 364, 370-371, 58 S.Ct. 899, 89 L.Ed. 1402.

described within sufficiently definable limits, and that therefore the non novel elements could be described in terms of function. 35 U.S.C.A. § 112; *Bryan* v. *Sid W. Richardson, Inc.*, 5 Cir. 1958, 254 F. 2d 191, 194; *Georgia Kaolin Co.* v. *Thiele Kaolin Co.*, 5 Cir. 1955, 228 F. 2d 267, 272.

Neither are we persuaded that the Arthur devices anticipated Hasha's kelly spinner. These power swivels are used to turn the drill string and there is no kelly described or claimed in the Arthur patents or devices. In any event, whether Arthur is a complete teaching of a kelly spinner; whether Arthur conceived of the kelly spinner before Hasha, and whether Arthur was diligent between the time he conceived the kelly spinner and the time he reduced it to practice, were all issues that were submitted to and determined by the jury. We cannot say that the verdict in this respect is not supported by the evidence.

It is significant that Hasha's invention was the first to supplant the use of the old spring chain and cathead for connecting the kelly to the drill pipe. It is obvious that the use of the spring chain was a very hazardous operation which had to be repeated every time a section was added to lengthen the drill string as the hole was deepened. The kelly spinner greatly enhanced the safety of oil field operations and was an immediate success. Not later than 1957 Foster recognized the need for a kelly spinner but did not develop its Model 77 spinner until about two years after the Hasha invention was commercialized.

As we said in *Samuelson* v. *Bethlehem Steel Company*, 5 Cir. 1963, 323 F. 2d 944, 947:

> 35 U.S.C.A. § 282 provides that
>
> > "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

> Any reasonable doubt will be resolved against the party alleging the invalidity of a patent. Mumm v. Decker & Sons, 1937, 301 U.S. 168, 171, 57 S.Ct. 675, 81 L.Ed. 983; Cameron Iron Works v. Stekoll, 5 Cir. 1957, 242 F. 2d 17; Jeoffroy Mfg. Co. v. Graham, 5 Cir. 1955, 219 F. 2d 511.

Without belaboring the point, the evidence was entirely sufficient to sustain the validity of the patent. The invention revolutionized the operation it was designed to accomplish. While it was a combination of old elements, the improvement was not obvious to persons skilled in the art; and the claims, as we limit them, define a patentable invention over the disclosure of the prior art. Hasha's device can be and is sustained as an improvement patent, but that only. The broad language in the claims cannot, however, be construed as Hasha would have us do, for if the claims be so extended they become invalid for want of sufficient disclosure. 35 U.S.C.A. §112; *Holland Furniture Co.* v. *Perkins Glue Co.*, 1928, 277 U.S. 245, 257, 72 L.Ed. 865, 873; *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 1938, 305 U.S. 47, 57, 83 L.Ed. 34, 39; *Texas Company* v. *Globe Oil & Refining Company*, 7 Cir. 1955, 225 F.2d 725, 735-37; *Phillips Petroleum Co.* v. *Shell Oil Co.*, 5 Cir. 1948, 166 F.2d 384, 386, *cert. denied* 335 U.S. 817. *Cf. Zenitherm Co.* v. *Art Marble Co. of America*, 5 Cir. 1932, 56 F.2d 39, 43.

The issue of infringement turns upon a comparison of Hasha's claims with Foster's device and upon the application of the doctrine of equivalents.

While there was some disagreement between the experts it is quite apparent, and Foster now tacitly concedes, that Hasha's claims fully read on Foster's device. All of the claims sued upon were admittedly added by Hasha after

he had seen Foster's device.[4] However, that Foster's device may come within the literal wording of Hasha's claims does not, in any event, end the matter.

> It is well settled that merely because the claims in suit taken literally read element by element on the accused device does not establish infringement, nor does it establish a presumption of infringement. The patentee in order to prove infringement has the burden of showing that the accused structure is the equivalent of the particular embodiment of the claimed structure disclosed in the specification and drawings. That is, the patentee, while he may be allowed some range of equivalents, must compare the accused structure with the patented structure as disclosed in the specification and drawings, and he must establish substantial identity of means, operation and result. Unless the patentee can carry this burden, the mere fact that his claims are broad when taken literally and clearly read on the accused device will avail him nothing. Morover, this is true regardless of the prior art. That is, even though the patentee may have developed a broad novel concept, a new function, done a thing never before done, yet he cannot patent all ways of doing the thing, even though he was the first to do it. Accordingly, no matter how broad the claims may be when taken literally, and even though they may avoid the prior art when given the broadest interpretation, nevertheless the claims can cover only the particular embodiment the patentee has disclosed and equivalents there-

[4] Such broad expressions as "gear means," "means to move said gear means," "means interposed between said motor means and the spindle for coupling said motor," and "additional gear means" were no doubt used in an attempt to cover both the Bendix arrangement and Foster's gear ring and the differently constructed and operating parts of Foster's device.

of. Of course, the range of equivalents will vary depending on the merit of invention.

C. Pigott, *Equivalents in Reverse,* 43 Journal of the Patent Office Society 291-92 (1966); *accord* 35 U.S.C. §112; *Graver Tank Co.* v. *Linde-Air Prod. Co.,* 1950, 339 U.S. 605, 608-09, 94 L.Ed. 1097, 1102, 70 S.Ct. 854; *Skirow* v. *Roberts Colonial House, Inc.,* 7 Cir. 1966, 361 F.2d 388, 391; *Texsteam Corp.* v. *Blanchard,* 5 Cir. 1965, 352 F.2d 983, 986; *Industrial Instrument Corp.* v. *Foxboro Co.,* 5 Cir. 1962, 307 F.2d 783, 785; *Stewart Warner Corp.* v. *Lone Star Gas Co.,* 5 Cir. 1952, 195 F.2d 645, 648; *Getty* v. *Kinsbach,* 5 Cir. 1941, 119 F.2d 249, 250, *cert. denied* 314 U.S. 651, 86 L.Ed. 522.

We conclude, from a detailed review of the testimony and the exhibits in the case, that there has been no infringement. The structures involved in the patent in suit and Foster's Model 77 spinner are relatively simple mechanical devices, and their manner of operation is undisputed. While infringement is usually a question of fact, that rule is subject to the exception that where, as here, the findings of infringement *vel non,* are based on inferences drawn from exhibits, documents, and uncontradicted testimony, rather than on the conflicting testimony of witnesses whose credibility is for the jury, such findings are subject to full review as questions of law. *Samuelson* v. *Bethlehem Steel Company, supra; Cameron Iron Works* v. *Stekoll,* 5 Cir. 1957, 242 F.2d 17, 21.[5]

[5] Hasha's expert did not testify about equivalency, nor did any of Hasha's other witnesses. The thrust of Hasha's argument is that there is a clear showing of equivalency because Foster filed an amendment to his application for patent in order to copy claims 1, 2, 3, 4 and 17 of Hasha's patent, claiming that they found response in the structure disclosed in his application. We disagree. This is simply the method by which an applicant initiates an interference with an issued patent. *Cf. Solomon* v. *Renstrom,* 8 Cir. 1945, 150 F.2d 805, 806. Further-

Of course, Hasha is entitled to a range of equivalents commensurate with the scope of his invention, but the range of equivalents is narrow because the scope of the invention is narrow. Patents on a rather simple combination of known mechanical elements, such as Hasha's, are difficult to obtain and are not easily infringed. *Texsteam Corporation* v. *Blanchard, supra,* at 986; *Industrial Instrument Corp.* v. *Foxboro Co.,* 5 Cir. 1962, 307 F.2d 783, 785; *Butex Gas Co.* v. *Southern Steel Co.,* 5 Cir. 1941, 123 F.2d 954, 956, *cert. denied* 315 U.S. 824; *Hughes* v. *Magnolia Petroleum Co.,* 5 Cir. 1937, 88 F.2d 817, 818.

Viewed in this light there is no infringement because the elements in the structures and the modes of operation are substantially different and the result accomplished is not the same. Of the four structural elements of Hasha's patent, *i.e.,* a support adapted to be carried by a spindle, a motor mounted on the support, a Bendix driven by the motor, and a separate gear ring mounted on the swivel spindle, Foster's device does not include either the Bendix or the ring gear mounted on the swivel spindle. These differences also result in three differences in operation. Hasha's Bendix arrangement automatically disconnects the motor from the spindle so that the spindle may be freely turned in either direction, while in Foster's Model 77 the motor must be reversed to back off the jaws before this is accomplished. Hasha's ring gear must be installed separately from the rest of the device and must be carefully

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more, Hasha's specifications and drawings were not considered by the patent office in the interference proceeding in determining whether Foster's patent application disclosed the claims he copied from the Hasha patent, and thus the patent office did no pass on whether or not the disclosures in Hasha's patent and the disclosures in Foster's application had substantially identical structure, mode of operation and results. Foster's asserted "response in the structure" was only a comparison of the literal wording of the Hasha claims with the structure in Foster's application.

aligned vertically so that it properly engages with the small gear in the Bendix. Foster has no separate attachment of the ring gear and no alignment of any gears. Hasha's device will turn the spindle in either direction by mere operation of the controls. Foster's device cannot reverse the direction of the spindle except by disassembling it, turning the jaws over and then reassembling the device.

As the Seventh Circuit recently said in *Skirow, supra,* "Neither a literal application of claim phraseology nor similarity of result is sufficient to establish infringement. There must be a real identity of means, operation and result." 361 F. 2d at 391.

We find that Hasha may not preclude Foster from making improvements on the prior art. Hasha designed around the prior art and Foster had the same right.[6] Applying the doctrine of equivalents within the narrow limits required, we hold that the accused Foster Model 77 spinner does not infringe Hasha patent No. 3,144,085. It follows that the judgment of validity is affirmed and that the judgment of infringement and injunction against Foster is hereby reversed.

REVERSED and REMANDED.

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[6] The prior art in this field consists of the Arthur power swivel already discussed, and a series of devices called power tongs manufactured by Foster. These devices, commencing as early as 1931 with Foster's patent No. 1,811,666, utilized the ring gear, drag ring, and jaw arrangement of the Model 77 kelly spinner. The same basic structure was used in Foster's "layout 38 spinner" (1954), and its "Model 50 tong" (1955).

APPENDIX

1. A device for rotating the spindle of a swivel including:

(a) support means adapted to be carried by a swivel having a spindle,

(b) motor means mounted on said support for imparting rotation to the spindle of the swivel,

(c) gear means between the spindle and said motor means, and

(d) means to move said gear means to disconnect said motor means from the spindle.

2. A device for rotating the spindle of a swivel including:

(a) support means adapted to be carried by a swivel having a spindle,

(b) motor means mounted on said support for imparting rotation to the spindle of the swivel.

(c) said motor means having a connection for receiving power from a power source whereby said motor may be actuated to rotate the spindle,

(d) gear means between the spindle and motor means, and

(e) means to move said gear means to disconnect said motor means from the spindle.

3. A device for rotating the spindle of a swivel including:

(a) support means adapted to be secured to a swivel having a spindle,

(b) motor means mounted on said support,

(c) said motor means having a connection for receiving power from a power source whereby said motor may be actuated,

(d) means for coupling said motor to the spindle for rotation thereof, and

(e) said last named means being uncoupled from the spindle but operable when said motor is actuated to couple said motor and spindle for rotation.

4. In a power spinner for rotating the spindle of a swivel.

(a) motor means adapted to be supported on the swivel and having a connection for receiving power from a power source whereby said motor may be actuated,

(b) a ring gear adapted to extend about the spindle for transferring rotation of said motor to the spindle,

(c) means interposed between said motor means and the spindle for coupling said motor and the spindle in one position for rotation, and for uncoupling said motor from the spindle in another position, and

(d) said motor being fixedly supported on the swivel in both positions.

12. An apparatus to be secured to a rotary swivel for rotating the spindle of the swivel comprising,

(a) a support adapted to be secured to the swivel,

(b) said support including an upper member and a lower member and means for maintaining said upper and lower support members in spaced relation.

(c) motor means carried by said support,

(d) said motor having a connection for receiving power from a power source whereby said motor may be actuated,

(e) gear means adapted to be rotated by said motor,

(f) an additional gear means for contacting the spindle and rotating it; and

(g) said gear means being in non-driving relation with said additional gear means and the spindle, and means operable when said motor is actuated to engage in driving relation with said additional gear means and spindle for imparting rotation to the spindle.

13. An apparatus to be secured to a rotary swivel for rotating the spindle of the swivel comprising,

(a) a support adapted to be secured to the swivel,

(b) motor means carried by said support,

(c) said motor having a connection for receiving power from a power source whereby said motor may be actuated,

(d) gear means adapted to be rotated by said motor,

(e) additional gear means for imparting rotation to the spindle engaged thereby, and

(f) said gear means being in non-driving relation with said additional gear means and the spindle, and means operable when said motor is actuated to engage in driving relation with said additional gear means and spindle for imparting rotation to the spindle.

15. The invention of claim 4 wherein said motor means is capable of rotating said ring gear clockwise and counterclockwise.

17. In a power spinner for rotating the spindle of a swivel,

(a) reversible motor means adapted to be supported for rotating the spindle on the swivel and having a connection for receiving power from a power source whereby said reversible motor means may be actuated.

(b) a ring gear surrounding the spindle for transferring rotation of said motor to the spindle,

(c) means interposed between said motor means and the spindle for coupling said motor and spindle in one position for rotation, and for uncoupling said motor from the spindle in another position, and

(d) said motor being fixedly supported on the swivel in both positions.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT
October Term, 1966

No. 23541

D. C. Docket No. 3-879-Civil Action

FOSTER CATHEAD COMPANY,

Appellant,

v.

MALVERN M. HASHA and INTERNATIONAL TOOL COMPANY, INC.,

Appellees.

Appeal from the United States District Court for the Northern District of Texas.

Before BELL, GODBOLD and DYER, Circuit Judges.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Texas, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed, and that this cause be, and the same is hereby remanded to the said District Court in accordance with the opinion of this Court;

It is further ordered and adjudged that the appellees, Malvern M. Hasha and International Tool Company, Inc., be condemned, in solido, to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

September 11, 1967

Issued as Mandate:

In The
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 23,541

FOSTER CATHEAD COMPANY,
Appellant,

v.

MALVERN M. HASHA and INTERNATIONAL TOOL COMPANY, INC.,
Appellees.

Appeal from the United States District Court
for the Northern District of Texas

ON PETITION FOR REHEARING
October 11, 1967

Before BELL, GODBOLD and DYER, Circuit Judges

PER CURIAM:

It is ORDERED that the petition for rehearing in the above entitled and numbered cause be, and the same is, hereby DENIED.

Petition for rehearing filed 9-29-67.

Petition for rehearing denied 10-11-67.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 892

MALVERN M. HASHA AND
INTERNATIONAL TOOL COMPANY, INC.,
Petitioners,

v.

FOSTER CATHEAD COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

An adequate reference to the opinion of the Court of Appeals below is made in the Petition.

JURISDICTION

The jurisdictional requisites are set forth in the Petition.

CONSTITUTIONAL PROVISION INVOLVED

Respondent believes that no constitutional provision is involved, but if it is, then it is the one set forth in the Petition at page 3.

QUESTIONS PRESENTED

It is respectfully submitted that the following single question, rather than the questions urged by the Petitioners, is the one correctly presented:

> Could the Court of Appeals hold, contrary to a jury finding, that a patent is not infringed where the structures involved in the patent and the alleged infringing structure were relatively simple mechanical devices, differing considerably, and there is no dispute in the record as to their manner of operation.

STATEMENT OF THE CASE

This is a civil action by the Petitioners, Malvern M. Hasha and International Tool Co., Inc., for alleged infringement by the Respondent, Foster Cathead Company, of claims 1, 2, 3, 4, 12, 13, 15, 16 and 17 of United States Letters Patent No. 3,144,085 issued August 11, 1964 for a Power Spinner Unit for Well Swivels. (R. 1112-1114) The trial was to a jury in the District Court which jury held the patent claims valid and all but one infringed. The District Court entered judgment in accordance with the verdict. (R. 1290-1292)

The Court of Appeals for the Fifth Circuit affirmed the judgment of validity and reversed the judgment of infringement. (Petition p. 18a, 29a and 34a) The Petitioners seek a review of the decision of the Court of Appeals in reversing the judgment of infringement.

The device of the patent in suit is used in drilling an oil well and is commonly known in the industry as a "kelly spinner". Respondent has only one form of device alleged to infringe and that is its Model 77 spinner. There is no dispute in the record as to the construction or mode of

operation or results accomplished by either the device of the patent or the Model 77 spinner.

The patent claims alleged to be infringed were admittedly added by Petitioner Hasha after seeing the Respondent's Model 77 spinner and for the express purpose of covering it. Petitioner Hasha used in these claims several broad expressions of "means" to do various things in an attempt to have the claims "literally read on" the Respondent's Model 77 spinner. (Petitioners' Ex. 32, R. 1589, Petition p. 26a, footnote 4)

The Court of Appeals correctly pointed out (and the Petitioners do not attack this in their petition) that a literal reading of such broad claims on an accused device does not establish infringement and for there to be infringement, the Petitioners had the burden of proving that the device of the patent and the accused device are equivalents, that is, they perform substantially the same function in substantially the same way to obtain substantially the same result. (Petition pp. 26a, 27a) The Court of Appeals then stated, in the following words, its right to determine if the jury had incorrectly found infringement:

> "We conclude, from a detailed review of the testimony and the exhibits in the case, that there has been no infringement. *The structures involved in the patent in suit and Foster's Model 77 spinner are relatively simple mechanical devices, and their manner of operation is undisputed.* While infringement is usually a question of fact, that rule is subject to the exception that where, as here, the findings of infringement *vel non,* are based on inferences drawn from exhibits, documents, and uncontradicted testimony, rather than on the conflicting testimony of witnesses whose credibility is for the jury, such findings are subject to full review as questions of law. *Samuelson* v. *Bethlehem Steel Company, supra; Cameron Iron Works* v. *Stekoll,* 5 Cir. 1957, 242 F.2d 17, 21." (Petition p. 27a)[1]

[1] Emphasis throughout is Respondent's unless otherwise indicated.

On the following page, the Court of Appeals pointed out:

> "Viewed in this light there is no infringement because the elements in the structures and the modes of operation are substantially different and the result accomplished is not the same." (Petition p. 28a)

It is language in the portion first quoted above of the decision of the Court of Appeals on which the Petitioners base their Petition.

ARGUMENT

Rule 19, which fixes the standard for granting writs of certiorari, requires there be "special and important" reasons for the writ. None such exist here. This is simply a patent case in which the Court of Appeals found that the undisputed evidence established there was no infringement of the monopoly of the patent and therefore it could and did reverse the judgment of the trial court entered on the jury verdict.

The Petitioners could not have ultimately succeeded in the Court of Appeals even if that court had affirmed the finding of infringement for the Court of Appeals held (Petition p. 27a):

> ". . . The broad language in the claims cannot, however, be construed as Hasha would have us do, *for if the claims be so extended they become invalid for want of sufficient disclosure.* (Citing authority)"

Furthermore, since the Court of Appeals held there was no infringement, it specifically did not pass on certain of Respondent's attacks on validity conditioned on the patent claims being construed broadly enough to be infringed.[2]

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[2] "As we shall later point out, the claims of Hasha's patent are embarrassingly broad and we are unwilling to extend his monopoly far beyond the invention. *Cf. Edwards* v. *Johnston Formation Testing Corporation,* 5 Cir. 1932, 56 F. 2d 49, 50. This pretermits the necessity for an extended discussion of the many pronged attack on validity by Foster premised upon a finding of infringement." (Petition p. 23a)

Petitioners' position appears to be (Petition p. 5) that the Court of Appeals was required to accept the jury's inference or conclusion of infringement even though the evidence on infringement was undisputed and that since the Court of Appeals did not do so, the decision of the Court of Appeals is contrary to decisions of this Honorable Court, especially in negligence cases.

Contrary to Petitioners' position, a patentee is not entitled to a monopoly of whatever scope favorably impresses a jury.[3]

There Is No Conflict Between the Action of the Court of Appeals in Reversing the Jury Finding of Infringement and Applicable Decisions of this Court.

The Court of Appeals stated in its decision:

> "The issue of infringement turns upon a comparison of Hasha's claims with Foster's device and upon the application of the doctrine of equivalents." (Petition p. 25a)

In this situation, the language of the Court of Appeals quoted on pages 3 and 4 hereof is strikingly similar to the language of this Honorable Court in *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265, 48 L. Ed 437 (1904) where both lower courts were reversed because the defendant's motion for directed verdict for lack of infringement was not granted. That case, like the case at bar, involved the question of equivalents and in its decision, this Honorable Court held:

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[3] In addition to *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265 (1904) discussed later herein, this Honorable Court in *Black Diamond Coal Manufacturing Co.* v. *Excelsior Coal Co.,* 156 U.S. 611, 618, 39 L. Ed. 553, 555 (1895) held with respect to patent infringement:

> "There was no question to go to the jury in the case, and the Court should have directed a verdict for the defendant."

". . . As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter, and as we are able, from mere comparison, to comprehend what are the inventions described in each patent, and, from such comparison, to determine whether or not the Diehl device is an infringement upon that of Cramer, *the question of infringement or no infringement is one of law,* and susceptible of determination on this writ of error. (Citing cases)" 192 U.S. at 275, of 48 L. Ed. at 443. * * *

". . . There is no substantial identity in the character of the two devices, unless, by substantial identity, is meant every combination which produces the same effect. The differences between the Diehl device and the Cramer construction are substantial, and not merely colorable." 192 U.S. at 286, 48 L. Ed. at 448.[4]

The paragraph first quoted above from *Singer Mfg. Co.* v. *Cramer* has been referred to with approval in the non-jury patent cases of *Sanitary Refrigerator Co.* v. *Winters,* 280 U.S. 30, 36, 74 L.Ed. 147, 153 (1929) and *United States* v. *Esnault-Pelterie,* 303 U.S. 26, 30, 31, 82 L.Ed. 625, 629 (1938).

The Petitioners' basic problem is that the Court of Appeals obviously decided the evidence on infringement, *vel non,* was so one-sided or overwhelming against infringement that the jury finding of infringement, whether based

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[4] Petitioners seek to distinguish this case (Petition p. 10) on the basis that in *Singer Mfg. Co.* v. *Cramer* the accused device was illustrated in a patent belonging to the defendant there which made comparison with the plaintiff's patent easy. However, in the case at bar the Court of Appeals specifically pointed out that both the patent and defendant's Model 77 spinner ". . . are relatively simple mechanical devices and their manner of operation is undisputed." (Petition p. 27a)

on inference, conclusion or otherwise, simply could not stand. Such a position is not in conflict with the applicable decisions of this Court.

The case of *Richmond & Danville R. Co.* v. *Powers,* 149 U.S. 43, 45, 37 L.Ed. 642, 643 (1893) in the very portion quoted by Petitioners (Petition p. 6) recognizes that for an inference from undisputed facts to be upheld, the inference must be one which "fair-minded men will honestly draw".

In *Gunning* v. *Cooley,* 281 U.S. 90, 94, 74 L.Ed. 720, 724 (1930) cited by Petitioners (Petition p. 6), this Honorable Court stated immediately preceding the portion quoted by the present Petitioners that inferences must be " . . . inferences that fairly are deducible . . . " and in the portion immediately following that quoted by the present Petitioners stated:

> "Where the evidence upon any issue is all on one side or so overwhelmingly on one side as to leave no room to doubt what the fact is, the Court should give a peremptory instruction to the jury. (Citing authority)."

Again, in *Tennant* v. *Peoria & P.U.R. Co.,* 321 U.S. 29, 35, 88 L.Ed. 520, 525 (1944) relied upon by the Petitioners (Petition p. 9), it is stated in the portion quoted by the Petitioners that:

> ". . . The focal point of judicial review is the *reasonableness* of the particular inference or conclusion drawn by the jury."[5]

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[5] Even *Hansen* v. *Safeway Stores,* 283 F. 2d 336 (9th Cir. 1956), the Court of Appeals case relied upon by Petitioners (Petition p. 7), which was a case involving validity rather than infringement, recognizes, ". . . the trial court can set aside the finding and enter a judgment for defendant if there are no grounds for the verdict." (238 F. 2d at 340)

In numerous cases this Honorable Court has held that a court has the right to review the reasonableness of a conclusion or inference made by a jury and set it aside where it is not reasonable. For example, in *Brady* v. *Southern Ry. Co.*, 320 U.S. 476, 479, 88 L.Ed. 239, 243 (1943), a Federal Employers Liability Act case, it was held:

> ". . . When the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict, the court should determine the proceeding by nonsuit, directed verdict or otherwise in accordance with the applicable practice without submission to the jury, or by judgment notwithstanding the verdict. By such proceeding of the trial the result is saved from the mischance of speculation over legally unfounded claims. (Citing authority)"

In *Pleasants* v. *Fant*, 89 U.S. 116, 122, 22 L.Ed. 780, 783 (1875) this Honorable Court had before it the question of whether or not the evidence established that the defendant was a partner in a firm. With respect to the point raised of foreclosure of a court's right to refuse to submit a case to a jury where the evidence is insufficient to support a verdict, it was stated:

> ". . . Such a proposition is absurd, and accordingly we hold the true principle to be, that if the court is satisfied that, conceding all the inferences which the jury could justifiably draw from the testimony, the evidence is insufficient to warrant a verdict for the plaintiff, the court should say so to the jury."

Southern Pac. Co. v. *Pool*, 160 U.S. 438, 440, 40 L.Ed. 485, 487 (1896) was an action to recover damages for death of the plaintiffs intestate. With respect to whether or not the deceased was guilty of contributory negligence, it was stated:

> ". . . There can be no doubt where evidence is conflicting that it is the province of the jury to determine, from such evidence, the proof which constitutes negligence. There is also no doubt where the facts are undisputed or clearly preponderant that the question of negligence is one of law. (Citing authority)"

Petitioners rely upon *Graver Tank Co.* v. *Linde Air Prod. Co.*, 339 U.S. 605, 609, 94 L.Ed. 1097, 1103 (1950) for the statement that in a patent infringement action, "A finding of equivalence is a determination of fact." Petitioners argue (Petition p. 8) that this matter of equivalence is one for the jury to determine based upon the credibility of the witnesses. However, in the same paragraph of *Graver Tank Co.* v. *Linde Air Prod. Co., supra,* quoted by the Petitioners, this Honorable Court held that a finding of equivalence was subject to the general principles of appellate review and the Court of Appeals here specifically found there was no question of credibility for the jury. As has been pointed out, this Honorable Court in *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265, 275, *supra* (a jury patent case) and in *Sanitary Refrigerator Co.* v. *Winters,* 280 U.S. 30, 36, *supra* (a non-jury patent case) has held the undisputed evidence can be such that a finding of infringement based on equivalents is reviewable as a matter of law. Also as shown early herein, negligence and similar questions which are normally questions of fact are similarly reviewable where the evidence does not support them.

This case involves merely the dispute between the Petitioners and the Court of Appeals as to whether there was sufficient evidence to support the jury finding of patent infringement in this particular case. It involves no unsettled important principles of law nor conflicts with decisions of this Honorable Court. Surely this case is not one in which there are "special and important reasons" for the granting of a writ of certiorari.

CONCLUSION

WHEREFORE, PREMISES CONSIDERED, Respondent prays that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

James F. Weiler

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Attorneys for Respondent

PROOF OF SERVICE

Service of this Brief for the Respondent in Opposition has been made upon Malvern M. Hasha and International Tool Co., Inc., Petitioners, by mailing a copy postage prepaid to Jack W. Hayden, 500 Jefferson Building, Suite 1111, Houston, Texas 77002, this 27th day of December, 1967.

James F. Weiler

James F. Weiler

Attorney for Respondent